

REMARKS

In the Office Action, the Examiner rejected claims 1-32. By the present Response, Applicant amended claims 1, 4, 9, 17, 20-23, and 26, added new claims 33-37, and canceled claims 27-32 without prejudice. Additionally, Applicant amended the title of the present application. Upon entry of the amendments, claims 1-26 and 33-37 are pending in the present patent application. In light of the forgoing amendments and the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-26 under 35 U.S.C. § 103(a) as obvious over the Dunton reference (U.S. Patent No. 6,337,919) in view of the Senior reference (U.S. Patent No. 6,400,836). Applicant, however, respectfully asserts that the instant claims are patentable over the cited references taken alone or in combination. In summary, Applicant respectfully asserts that the instant claims recite features not found in either of the references. Moreover, Applicants respectfully assert that the cited references lack the necessary motivation for combination and, as such, do not support a *prima facie* case of obviousness.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q. 2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Furthermore the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q. 2d. 1430 (Fed. Cir. 2002) (emphasis added). Indeed, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F. 2d 1044, 5 U.S.P.Q. 2d 1434 (Fed. Cir. 1988). One cannot use the hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F. 2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

With the forgoing in mind, Applicant respectfully asserts that the instant claims are patentable over the cited references.

Independent Claims 1, 9, 17, 22, 23, and 26 and the Claims Depending Therefrom

Each of the independent claims recites, in various permutations and combinations, a driver, computer, and/or software capable of performing a function in cooperation with a fingerprint scanner, wherein the function comprises at least one of a *zoom function* and *hot-key function*. Specifically, the independent claims in the instant patent application recite as follows:

Claim 1: “a driver operably coupled to the fingerprint scanner to enable the fingerprint scanner to perform a function, wherein the function comprises at least one of a *zoom function* and a *hot-key function*;”

Claim 9: “a driver to configure the fingerprint scanner to perform at least one of a *zoom function* and a *hot-key function* on the computer;”

Claim 17: “configuring a computer to perform at least one of a *zoom function* and a *hot-key function* in response to signals generated by the fingerprint scanner;”

Claim 22: “providing software that configures the processor to interpret signals from the fingerprint scanner as at least one of a *zoom function* and a *hot-key function*;”

Claim 23: “moving a finger on the fingerprint scanner to cause the one of a *zoom* and a *hot-key function*;” and

Claim 26: “means for configuring a computer to perform at least one of a *zoom function* and a *hot-key function* in response to signals generated by the fingerprint scanner.”

(Emphasis added.) Respectfully, Applicant asserts that the cited references taken alone or in combination do not disclose all of these recited features. Moreover, Applicant respectfully asserts that the cited references lack the necessary motivation for combination to reach the instant claims.

Cited References Fail to Disclose ALL of the Features Recited in the Instant Claim

Neither the Dunton reference nor the Senior reference discloses any semblance of a *zoom function* or a *hot-key function*, as recited in the instant claim. Indeed, nothing in either the Senior reference or the Dunton reference even suggests a component capable of *zoom functionality* and/or *hot-key functionality*, as recited in the instant claims. Therefore, Applicant respectfully asserts that the cited references, taken alone or in combination, do not disclose all of the features recited in the instant claims.

Cited References lack the Requisite Motivation for Combination

Additionally, the cited references lack the requisite motivation for combination to reach the instant claims and to support a *prima facie* case of obviousness.

For example, the Dunton reference discloses a *traditional* mouse 10 that includes a fingerprint scanning system for security. *See* Dunton, Fig. 1; col. 1, ll. 55-58. Although the mouse 10 of the Dunton reference includes an optical system 22 and fingerprint sensor 24, these systems and sensors do not assist operations and/or functionality of the mouse by any means whatsoever. Indeed, the Dunton reference notes that movements of an operator’s finger can negatively affect the focus of the fingerprint sensor 24 and, as such, prevent adequate imaging by the fingerprint sensor. *See* Dunton, col. 2, ll. 36-42 (stating that “[s]ince in many cases, the amount of *deflection* of the mouse button is relatively *small*, *focus* may not be a serious concern”) (emphasis added). Thus, the Dunton reference *teaches away* from the

use of the disclosed fingerprint scanner 24 and sensor for functionality beyond that of basic security, because movements of an operator's finger *negatively affect* the disclosed sensor 24 and optical system 22. Accordingly, the Dunton reference teaches that the disclosed fingerprint scanning system is operable *solely* for the purpose of security and, as such, teaches away from the combination with the Senior reference to reach the instant claims.

Therefore, Applicant respectfully asserts that the cited references lack the requisite motivation for combination to support a *prima facie* case of obviousness with respect to the instant claims. With the foregoing in mind, Applicant respectfully asserts that all of the pending claims are pending claims are patentable and in condition for allowance. Respectfully, Applicant requests reconsideration and allowance of all pending claims.

Conclusion

In view of the remarks set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Manish Vyas
Reg. No. 54,516
(281) 970-4545

Date: June 10, 2004

Correspondence Address:

Hewlett-Packard Company
IP Administration
P.O. Box 272400
Fort Collins, CO 80527-2400